

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

4243-02700

## CERTIFICATE OF FILING

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Katherine Yee

Application Number

10/758,459

Filed

January 15, 2004

First Named Inventor

Thomas Lummis

Art Unit

3781

Examiner

Tri M. Mai

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

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applicant/inventor.

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assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

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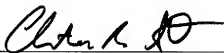
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Registration number if acting under 37 CFR 1.34



Signature

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February 19, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

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\*Total of forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**REASONS FOR REQUESTING PRE-APPEAL BRIEF REVIEW**

Claims 1-15 are currently pending in the application, as listed on pages 2-7 of the Response to Office Action filed by Applicants on November 7, 2008. In the Final Office Action dated December 17, 2008, all claims were rejected under 35 USC §112 or §103.

**I. Claim Rejections – 35 USC § 112**

Claims 1-15 have been rejected under 35 USC §112, with the Final Office Action of 12/17/2008 stating that the claims are “indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” For such a §112 analysis, the fundamental factual inquiry is “whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art.” *MPEP 2171*. In this instance, a person skilled in the art field certainly would understand the claims in light of the description set forth in the Specification text. Thus, Applicants suggest that the §112 rejection is improper and should be withdrawn.

It seems that the examiner’s real concern here is not whether the claims are indefinite; rather the examiner simply does not believe “Applicant’s assertion that having only one support [per side of the module] as compared having multiple support locations would enhance the cover’s ability to withstand peak wind conditions” (indicating that it “contradicts physic laws”). This is not a proper reason for a §112 rejection, however, since the claim limitation of using one support strap (providing “no more than one point of contact”) on each side of the module is clearly supported by the Specification (see Specification p. 6, lines 22-27; p. 7, lines 2-5; and Figs. 1-2), and would certainly be understood by those skilled in the art. Thus, Applicants request withdrawal of the §112 rejection.

Applicants also note for convenience that the evidence does indeed indicate that Applicants’ assertion, while surprising, is in fact true. Specifically, the Taubert declaration describes side-by-side field tests of about 1,000 *Porter* covers (having multiple support straps per side) and about 1,700 of the presently claimed (single support strap per side) covers for over three years (see *Taubert declaration, paragraphs 6-12*), and notes that these field tests demonstrate that the presently claimed (single support strap per side) “covers are surprisingly superior at staying in place on the cotton module.” See *Taubert Declaration, paragraph 13*. More specifically, Mr.

Taubert notes that while about 40% of the *Porter* covers were lost during the side-by-side field testing, none of the presently claimed covers were lost. See *Taubert Declaration, paragraph 14*. Furthermore, the Taubert declaration provides nexus by linking the superior results of the presently claimed invention to the single support strap per side (noting in paragraph 10, for example, that the *Porter* cover is essentially the same as the presently claimed invention, except that *Porter* uses multiple support straps per side; this can also be seen directly by comparing Figs. 16 and 19 of *Porter* to the drawings of the present invention). So, the objective data reported in the previously presented Taubert declaration clearly demonstrates that the presently claimed covers “perform significantly better in real-world conditions” than the *Porter* covers of the cited prior art. Since any ultimate decision must be made on the evidence, and the only evidence on this point is the Taubert declaration which supports patentability, Applicants respectfully request that the §112 rejection be withdrawn, and that claims 1-15 be found in condition for allowance.

## **II. Claim Rejections – 35 USC §103**

Claims 1-15 have been rejected under §103 based on the *Porter, Frieder, Horwath, Gallagher*, and/or *Campbell* references, with the final office action of 12/17/2008 stating that “it would have been obvious to one of ordinary skill to provide only one support.” Applicants, however, respectfully disagree with these rejections for at least the following reasons:

### **A. The *Porter* reference cannot render the claimed invention obvious**

It seems strange that the examiner would with one breath say that the claimed superiority of the present invention (with one support strap per side) contradicts the laws of physics, and then in the very next breath say that such a one-strap-per-side invention would be obvious. The examiner’s very own reaction (indicating that “Applicant’s assertion that having only one support as compared having multiple support location would enhance the cover’s ability to withstand peak wind condition contradicts physic laws”) emphasizes that no person of skill would be obviously led towards the presently claimed invention. The surprising finding that the present invention’s use of a single support strap point of contact per side is superior to *Porter*’s multiple strap cover runs counter to intuition.

Further, the Taubert declaration (providing first-hand objective eyewitness evidence of over 3 years of side-by-side field testing) demonstrates the unexpectedly superior results achieved

by the present invention, which were surprising even to a person as experienced in this field as Mr. Taubert (who has over 19 years of experience). The 40% improvement described in paragraph 14 of the Taubert declaration is clearly both significant and surprisingly unexpected. In fact, the results were so significant that Mr. Taubert stopped using *Porter* covers and switched exclusively to the present invention (with a single strap per side). See *Taubert declaration, paragraphs 13, 15, and 16*. And Mr. Taubert, a representative person of skill in the art field, was surprised by the superior performance of the present invention, as described in paragraphs 1-4 and 19-20. Furthermore, the Taubert declaration provides nexus linking the superior results of the presently claimed invention to the single support strap per side (noting in paragraph 10, for example, that the *Porter* cover is essentially the same as the presently claimed invention, except that *Porter* uses multiple support straps; this can also be seen directly by comparing Figs. 16 and 19 of *Porter* to the drawings of the present invention).

Clearly, the Taubert declaration provides good evidence of non-obviousness, and this evidence must be considered by the examiner. The PTO's own rules state that evidence cannot be disregarded, and that all evidence must be considered and weighed. For example, MPEP 716.01 requires that "evidence traversing rejections, when timely presented, must be considered by the examiner whenever present," while noting that this applies to "all evidence traversing rejections submitted by applicants, including affidavits or declarations." And MPEP 716.01(c)III notes that even opinion "testimony is entitled to consideration." Thus, the Taubert declaration, with its third-party eyewitness testimony regarding the results of side-by-side field tests (as described above and in the previous response of June 13, 2008, hereby fully incorporated), clearly is evidence that must be considered.

Further, "when an applicant timely submits evidence traversing a rejection, the examiner must reconsider the patentability of the claimed invention," with the "ultimate determination of patentability [being] based on consideration of the entire record, by a preponderance of evidence." *MPEP 716.01(d)*. Thus, the evidence of non-obviousness submitted by the Applicants in the Taubert declaration must be weighed against any countervailing evidence of obviousness presented by the examiner. Such a weighing of evidence in this case clearly indicates that the invention is non-obvious. After all, the only evidence comparing the effectiveness of the present invention to the *Porter* cover is the Taubert Declaration, which indicates that in side-by-side field tests, the

present invention showed a 40% improvement over the *Porter* cover. See *Taubert Declaration, paragraph 14*. The Declaration has not been refuted or contradicted by any countervailing evidence. Instead, the examiner seems to have relied exclusively on conclusory statements arising from a gut feeling that this one-strap-per-side invention cannot possibly perform better than a multi-strap cover. But “rejections on obviousness grounds cannot be sustained by mere conclusory statements.” *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398; 127 S.Ct. 1727 (U.S. S.Ct., 2007).

Since the previously submitted Taubert Declaration is the only evidence on this matter, an impartial weighing of evidence clearly points to non-obviousness. And as noted above, the non-obviousness clearly demonstrated in the Taubert declaration is further strengthened by the examiner’s initial reaction that this “contradicts physic laws.” After all, the examiner’s own reaction further demonstrates that persons of skill would react with disbelief, and that prior to the present invention, a person of skill in the field simply would not be obviously led towards the presently claimed invention. This is the very essence of non-obviousness. So for all of these reasons, the present invention clearly cannot be obvious based on the cited *Porter* reference.

#### **B. The cited secondary references do not lead towards the claimed invention**

Furthermore, the cited secondary references for use in conjunction with *Porter* would not lead a person of ordinary skill towards the presently claimed invention, as noted previously in the response of June 13, 2008 and fully incorporated herein. The *Frieder*, *Campbell*, and *Horwath* references each deal with netting (rather than any sort of solid cover), and so they are not relevant - their open mesh netting could not offer any rain protection and would not experience the uplift forces from wind which are the key issue in the present invention. And the *Gallagher* reference is also irrelevant, since it deals with a side mounted air conditioner cover that also could not offer rain protection and would not experience wind uplift forces. Quite simply, these cited references would not lead a person of skill at the time of invention towards the presently claimed invention.

#### **III. Preservation of Additional Grounds for Appeal**

In an effort to simplify the issues for consideration by the panel, Applicants have focused this discussion on the larger concerns. However, Applicants reserve the right to pursue additional grounds for appeal should the panel elect to uphold the rejections.

IV. Summary

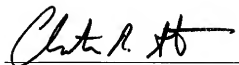
Applicants submit that the grounds of rejection are improper at least because both the Taubert declaration and the examiner's own reaction of disbelief demonstrate that persons of skill would not be led towards the present invention. Consequently, the references fail to render the pending claims obvious as required by 35 USC §103. Furthermore, Applicants submit that the claims are clearly supported by the original Specification, and so the §112 rejection is improper. Accordingly, Applicants respectfully request that the rejections be withdrawn and that the pending claims be allowed. If necessary, additional details on Applicants' points may be found in the Responses dated June 13, 2008 and November 7, 2008, along with the Taubert Declaration submitted June 13, 2008, all of which are hereby fully incorporated herein.

Respectfully submitted,

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